

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Gianfranco D'Amato	Art Unit :	3782
Serial No. :	10/583,181	Examiner :	Christopher R. Demeree
Filed :	April 23, 2007	Conf. No. :	7651
Title :	BLANK FOR A CONTAINER AND A CONTAINER MADE FROM SAID BLANK		

Commissioner for Patents  
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PRE-APPEAL BRIEF

Applicant submits this request under the Pre-Appeal Conference Pilot Program described in the U.S. Patent and Trademark OG Notice, "New Pre-Appeal Brief Conference Pilot Program," dated July 12, 2005 and extended until further notice as of January 10, 2006. This request is being filed with a Notice of Appeal. Applicant requests review of the matters discussed below by a panel of examiners, because the rejections under 35 U.S.C. § 103 in the final office action of July 21, 2011 and maintained in the advisory action of December 8, 2011 are clearly improper.

In the advisory action, the examiner maintained the rejections of claims 1-7, 9-11, 22, 25-28 and 30-35 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,153,911 (Benedetti) in view of U.S. Patent No. 3,482,765 (Probst). In particular, the examiner continues to assert that it would have been obvious to modify Benedetti's liquid container to include a peripheral recess in each overlapping portion 8, 9 of the container, in view of the overlapping groove design (*e.g.*, at 14 and 16) in Probst's church contribution envelope. As discussed below, the applicant disagrees.

As discussed below, the Examiner is wrong for several reasons.

First, the concerns addressed by the openings in Probst's church contribution envelope have no applicability whatsoever to a liquid container, such as the one disclosed in Benedetti. Therefore, a person of ordinary skill would have had no reason to modify Benedetti's liquid container in view of the openings in Probst's church contribution envelope.

In particular, Probst's church contribution envelope (*see, e.g.*, FIG. 2) has openings in the back of the envelope but not the front of the envelope. Col. 1, lines 13-18. This arrangement of

openings (on one side only): (1) enables religious organizations that receive a large number of these envelopes with financial contributions to easily check if an envelope is empty or not before discarding it; and (2) conceals the contents of the envelope for privacy purposes in consideration of contributors who want the amount of their donation to remain confidential. Additionally, this arrangement provides considerable space on the front of the envelope for printed material. *See, e.g.,* col. 1, lines 34-42 and col. 2, lines 38-46.

These concerns have no applicability whatsoever to a liquid container, such as the one disclosed in Benedetti and, therefore, a person of ordinary skill would have had no reason to modify Benedetti's liquid container in view of the teachings related to the openings in Probst's church contribution envelope.

Moreover, the examiner has not articulated anything about the overlapping nature of the grooves (*e.g.*, 14 and 16) in Probst's church contribution envelope that would have led a person of ordinary skill to modify Benedetti's inspection window. In this regard, the applicant submits that a person of ordinary skill would have been discouraged from making such modifications (*e.g.*, adding a cut to overlapping portion 8) because doing so would have complicated the structure of Benedetti's container and potentially compromised its liquid-tightness, particularly in the area of the inspection window, with no discernable benefits based on the prior art.

Claim 1 is allowable for at least the foregoing reasons.

Additionally, the cited references, alone or in any reasonable combination, do not disclose or render obvious the subject matter recited in claim 1.

For example, claim 1 recites "[a] blank for a container wall comprising: an upper and a lower peripheral edge; first and second connection edges laterally connecting said peripheral edges, each of said connection edges extending along overlap regions which are interconnectable for shaping the container; and at least one peripheral recess that is open to the outside and formed in each of the overlap regions."

The final office action alleges that Benedetti's overlapping portions 8, 9 (see Fig. 1) correspond to the "overlap regions" in claim 1. However, Benedetti's container does not include "at least one peripheral recess that is open to the outside and formed in each" overlapping portion 8, 9, as recited in claim 1. Indeed, only overlapping portion 9 has a peripheral recess (formed by cut 10); overlapping portion 8 does not have a peripheral recess.

The advisory action states that "[i]t would have been obvious to include a recess in Benedetti's opposed peripheral edge (8) in order to widen the inspection opening of Benedetti's container." However, without the benefit of impermissible hindsight, the applicant submits that a person of ordinary skill seeking to widen (or, for that matter, narrow) Benedetti's inspection window could have simply increased (or decreased) the depth of the existing cut 10 or made the overlapping portion 8 smaller. Without the benefit of impermissible hindsight provided by the present disclosure, the person of ordinary skill simply would have had any reason to make a further cut into overlapping portion 8, as the examiner suggests would have been obvious.

Therefore, no reasonable combination of Benedetti and Probst would include "[a] blank for a container wall comprising: an upper and a lower peripheral edge; first and second connection edges laterally connecting said peripheral edges, each of said connection edges extending along overlap regions which are interconnectable for shaping the container; and at least one peripheral recess that is open to the outside and formed in each of the overlap regions," as recited in claim 1.

Claim 1 is allowable for at least the foregoing additional reasons.

Moreover, claim 1 recites "a first overlap line and a second overlap line, wherein upon connection of the overlap regions, [a] first connection edge substantially aligns with the second overlap line and [a] second connection edge substantially aligns with the first overlap line, wherein an inner edge of a first one of the overlapping peripheral recesses extends at least in part along the first overlap line and an inner edge of a second one of the overlapping peripheral recesses extends at least in part along the second overlap line."

The foregoing claim features can be appreciated by referring to the exemplary blank shown in Fig. 1 of the present application:

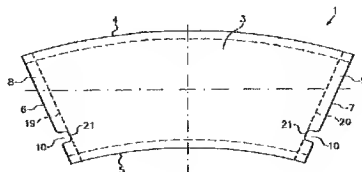


Fig. 1

The blank in Fig. 1 has a first overlap line 19 and a second overlap line 20. Upon connection of the overlap regions (8 and 9), a first connection edge 6 substantially aligns with the second overlap line 20 and the second connection edge 7 substantially aligns with the first overlap line 19 and an inner edge 21 of a first one of the overlapping peripheral recesses 10 extends at least in part along the first overlap line 19 and an inner edge 21 of a second one of the overlapping peripheral recesses 10 extends at least in part along the second overlap line 20.

The cited references, alone or in any reasonable combination, do not disclose or render obvious the claimed subject matter.

Benedetti clearly does not disclose or suggest the claimed subject matter. Indeed, neither the final office action nor the advisory action suggests anything contrary.

Probst also does not disclose or suggest the claimed subject matter. The church contribution envelope in Probst has grooves 14, 16, 18, 20 in some of the flaps 10, 12, 8 which partly overlap when the flaps 10, 12, 8 are folded. *See, e.g.,* figs. 1 and 2. However, the corresponding parts of grooves 14 and 20 visible in Fig. 2 are not arranged in "overlap regions," as recited in claim 1.

Moreover, the corresponding parts of grooves 14 and 20 visible in Fig. 2 of Probst are not arranged such that there is "a first overlap line and a second overlap line, wherein upon connection of the overlap regions, the first connection edge substantially aligns with the second overlap line and the second connection edge substantially aligns with the first overlap line, wherein an inner edge of a first one of the overlapping peripheral recesses extends at least in part along the first overlap line and an inner edge of a second one of the overlapping peripheral recesses extends at least in part along the second overlap line," as recited in claim 1.

Claim 1 is allowable for at least the foregoing additional reasons as well.

Claims 2-7 and 9-11 and 32-35 depend from claim 1 and, therefore, are allowable for at least the same reasons as claim 1.

Claim 22 recites subject matter that is similar to the subject matter in claim 1, discussed above. Claim 22, therefore, is allowable for at least the same reasons as claim 1.

Claims 25-28 and 30-35 depend from claim 1 and, therefore, are allowable for at least the same reasons as claim 1.

In the final office action, claim 23 and 24 were rejected under 35 U.S.C. §103(a) as unpatentable over Benedetti in view of Probst and further in view of U.S. Patent No. 5,031,826 ("Seufert"); and claim 29 was rejected under 35 U.S.C. §103(a) as unpatentable over Benedetti in view of Probst and further in view of U.S. Patent No. 6,378,763 ("Nelson").

Claims 23, 24 and 29 depend from allowable claims and, therefore, are allowable for the same reasons as the claims from which they depend.


### Conclusion

It is believed that all rejections of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: January 20, 2012

  
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